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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,545	06/18/2001	Takeshi Fujita	450131-03247	1281
20999 7590 02/21/2007 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER ZHOU, TING	
			ART UNIT 2173	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/806,545		FUJITA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Ting Zhou		2173	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8-13, 15 and 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The Request for Continued Examination (RCE) filed on 11/20/2006 under 37 CFR 1.53(d) based on parent Application No. 09/806,545 is acceptable and a RCE has been established. An action on the RCE follows.

2. The amendments filed on 11/01/2006, submitted with the filing of the RCE have been received and entered. Claims 1-13, 15 and 17-24 as amended are pending in the application.

### ***Allowable Subject Matter***

3. Claims 1-7 are allowed.

4. The following is an examiner's statement of reasons for allowance: The present invention teaches embedding identification information into image files associated with displayable images in order to prevent unauthorized redirecting from a displayed image. Each of the independent claims identifies the distinct feature of adding unique identification information to identify access to the image file when a user accesses the image file. The closest prior art, Iwamura U.S. Patent 6,807,285 and Hoyle U.S. Patent 6,141,010 teach the embedding of identification information to prevent unauthorized redirecting from a displayed image. In the case of the Iwamura reference, Iwamura teaches means for receiving a displayable image and related data to the displayable image (the apparatus is supplied, or receives a displayable image G and related data, such as public key information and embedding information) (Iwamura: column 5, lines 15-21 and lines 53-61); means for recording the displayable image into the image file (recording, or

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loading the image data and related information into a file format shown in Figure 11) (Iwamura: column 17, line 43-column 18, line 4); means for embedding unique identification information which uniquely identifies the image file into a non-displayable portion of the image file (embedding information that identifies the image such as image format identification data into the image header, which is not displayed when displaying the image from the image file) (Iwamura: column 17, line 58-column 18, line 4 and Figure 11); and means for preventing unauthorized redirecting from the displayable image by embedding the related data into the image file, which already includes the displayable image (embedding related data such as the watermark and confidential information into the image file comprising the image data G in order to prevent illegal copies or alteration/destruction of the image) (Iwamura: column 1, lines 33-48, column 5, lines 41-47 and column 6, lines 23-31). In the case of the Hoyle reference, Hoyle teaches pointers to at least one item of information enabling redirection from the displayable image to a site having the at least one item of information (the image file data sets comprise a number of user selectable links, or pointers, that will cause redirection to the corresponding URL site upon selection) (Hoyle: column 4, lines 19-49). However, the prior art teaches the identification information indicates the image format name, file size, image width, etc. and does not teach identification information that identifies access to the image file when a user accesses the image file. Therefore, the prior art fails to anticipate or render the above limitations obvious.

5. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Claims 8-13, 15 and 17-24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs, set forth in this Office action.

7. The following is a statement of reasons for the indication of allowable subject matter:

The present invention teaches embedding identification information into image files associated with displayable images in order to prevent unauthorized redirecting from a displayed image.

Each of the independent claims identifies the distinct feature of adding unique identification information to identify access to the image file when a user accesses the image file. The closest prior art, Iwamura U.S. Patent 6,807,285 and Hoyle U.S. Patent 6,141,010 teach the embedding of identification information to prevent unauthorized redirecting from a displayed image. In the case of the Iwamura reference, Iwamura teaches means for receiving a displayable image and related data to the displayable image (the apparatus is supplied, or receives a displayable image G and related data, such as public key information and embedding information) (Iwamura: column 5, lines 15-21 and lines 53-61); means for recording the displayable image into the image file (recording, or loading the image data and related information into a file format shown in Figure 11) (Iwamura: column 17, line 43-column 18, line 4); means for embedding unique identification information which uniquely identifies the image file into a non-displayable portion of the image file (embedding information that identifies the image such as image format identification data into the image header, which is not displayed when displaying the image from

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the image file) (Iwamura: column 17, line 58-column 18, line 4 and Figure 11); and means for preventing unauthorized redirecting from the displayable image by embedding the related data into the image file, which already includes the displayable image (embedding related data such as the watermark and confidential information into the image file comprising the image data G in order to prevent illegal copies or alteration/destruction of the image) (Iwamura: column 1, lines 33-48, column 5, lines 41-47 and column 6, lines 23-31). In the case of the Hoyle reference, Hoyle teaches pointers to at least one item of information enabling redirection from the displayable image to a site having the at least one item of information (the image file data sets comprise a number of user selectable links, or pointers, that will cause redirection to the corresponding URL site upon selection) (Hoyle: column 4, lines 19-49). However, the prior art teaches the identification information indicates the image format name, file size, image width, etc. and does not teach identification information that identifies access to the image file when a user accesses the image file. Therefore, the prior art fails to anticipate or render the above limitations obvious.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 8-13, 15 and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "tangible storage medium", on lines 1-2 of claim 8 is not positively recited in the specification of the present application. The specification states, on lines 17-18 of page 40, "Further, the information image file may be supplied from a computer readable recording medium such as CDROM." However, the cited passage merely indicates an example of computer readable recording mediums, but does not provide a definition of what constitutes a "tangible" storage medium. Without a standard or definition of what is considered "tangible" storage medium, it is unclear what storage mediums are considered tangible and what storage mediums are not considered tangible. Therefore, there is no positively recited basis for "a tangible storage medium". Claims 9-13, 15 and 17-20 are dependent upon claim 8, and are rejected for similar reasons.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 20-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites the limitation "The computer readable medium" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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Claims 21-24 recite the limitation "The device" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TZ



Kieu D. Vu  
Primary Examiner